



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,916	02/20/2001	Eran Aharonson	P-3291-US	3792

7590 08/31/2005
PEARL, COHEN, ZEDEK & LATZER, LLP
10 ROCKEFELLER PLAZA
SUITE 1001
NEW YORK, NY 10020

EXAMINER

MARIAM, DANIEL G.

ART UNIT PAPER NUMBER

2625

DATE MAILED: 08/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/733,916

Applicant(s)

AHARONSON, ERAN

Examiner

DANIEL G. MARIAM

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Arguments

1. Applicant's arguments, see the remarks pages 2-4, filed April 20, 2005, with respect to the rejection(s) of claim(s) 1-18 under 35 USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Skinner (US Patent No. 6,661,920).

Claim Suggestions

2. Claims 1, 13 and 15 include a recitation of the intended use (i.e., adapted to) of the claimed invention which must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). Replacing it with "configured to or arranged to" may modify the claim language "adapted to".

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

While claims 4-5 and 9-10 recite the limitation "at least one activatable menu control associated with a multiplicity of said activatable controls and at least one activatable menu control associated with a multiplicity of other activatable menu controls, only a cursory is

Art Unit: 2625

mentioned on page 2, lines 11-17 of the specification. It is unclear how and why the menu control is associated with the activatable controls. Please clarify.

4. rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 6, 8, 11-14 and 17-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Skinner (6,661,920).

With regard to claim 1, Skinner discloses a handwriting recognition input system (See for example, Fig. 6) comprising:

a handwriting input area (See for example, item 105, 310 and/or 410, in Figs. 2 and 6-7);
and a plurality of activatable controls (which correspond to item 106a and 106b, for example) each being associated with a different reference library, i.e., alphabetic character, numeric character and punctuation character, and each *adapted to* recognizing characters input on said handwriting input area as belonging to said associated reference library (when numeric data is entered, region 2 or 106b will be activated and the numeric data entered by a user will be

Art Unit: 2625

recognized as numbers, and if on the other hand, an alphabet is entered region would be activated and recognized as letters) (See Figs. 2 and 6-7; and col. 7, line 41 – col. 8, line 6).

With regard to claim 2, a handwriting recognition input system according to claim wherein at least one of said plurality of activatable controls is a software control (See for example, item 315, in Fig. 6).

With regard to claim 3, a handwriting recognition input system according to claim 1, wherein at least one of said plurality of activatable controls is a hardware control (See item 106, in Figs. 2 and 6).

With regard to claim 6, - A personal digital assistant, i.e., portable or palmtop computer, having a handwriting recognition input system according to claim 1 (See Figs. 1-3).

With regard to claim 8, a plurality of activatable controls (which correspond to item 106a and 106b, for example) each associated with a reference library, i.e., alphabetic character and numeric character,; and a handwriting recognition unit for controlling handwriting recognition in accordance with at least one activated control (when numeric data is entered, region 2 or 106b will be activated and the numeric data entered by a user will be recognized as numbers, and if on the other hand, an alphabet is entered region would be activated and recognized as letters) (See Figs. 2 and 6-7; and col. 7, line 41 – col. 8, line 6).

Claim 11 is rejected the same as claim 6. Thus, argument similar to that presented above for claim 6 is equally applicable to claim 11.

With regard to claim 13, a personal digital assistant, i.e., handheld, portable or palmtop computer (See Figs. 1-3), comprising: a housing (which reads on Fig. 2a); a handwriting input area mounted on said housing (See for example, item 105, in Fig. 2a); a plurality of

Art Unit: 2625

activatable controls (which correspond to item 106a and 106b, for example) each being associated with a different reference library, i.e., alphabetic character and numeric character, and each *adapted to* recognizing characters input on said handwriting input area as belonging to said associated reference library (when numeric data is entered, region 2 or 106b will be activated and the numeric data entered by a user will be recognized as numbers, and if on the other hand, an alphabet is entered region would be activated and recognized as letters) (See Figs. 2 and 6-7; and col. 7, line 41 – col. 8, line 6).

With regard to claim 14, a personal digital assistant, i.e., handheld, portable or palmtop computer (See Figs. 1-3), comprising, a housing (which reads on Fig. 2a); a plurality of activatable controls (which correspond to item 106a and 106b, for example) each associated with a reference library, i.e., alphabetic character and numeric character,; and a handwriting recognition unit for controlling handwriting recognition in accordance with at least one activated control (when numeric data is entered, region 2 or 106b will be activated and the numeric data entered by a user will be recognized as numbers, and if on the other hand, an alphabet is entered region would be activated and recognized as letters) (See Figs. 2 and 6-7; and col. 7, line 41 – col. 8, line 6).

With regard to claim 17, selecting at least one character set from among a plurality of character sets, and recognizing at least one character using said at least one selected character set (See for example, col. 7, line 55 through col. 8, line 41; and col. 9, lines 30-42).

With regard to claim 18, claim 1 encompasses the limitation of this claim except claim 18 is a method claim. Thus, argument similar to that presented above for claim 1 is equally applicable to claim 18.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 7, 12 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skinner (6,661,920) in view of Krieter (5,526,411).

With regard to claim 15, Skinner discloses all of the claimed subject matter as already addressed above for claim 13, and the arguments are not repeated herein, but are incorporated by reference. Skinner does not expressly call for a mobile telephone. However, Krieter (col. 4, line 53 – col. 5, line 13) teaches this feature. Therefore, it would have been obvious to one having ordinary skill in the art to incorporate the teaching as taught by Krieter into the system of Skinner, and to do so would at least provide an integrated portable phone and personal computing device having a handheld body structure that allows the device to be comfortably held as a telephone receiver (See for example, col. 2, lines 38-41).

Claims 7 and 12 are rejected the same as claim 15. Thus, argument similar to that presented above for claim 15 is equally applicable to claims 7 and 12.

Claim 16 is rejected the same as claim 14. Thus, argument analogous to that presented above for claim 14 is equally applicable to claim 16. Claim 16 distinguishes from claim 14 only in that it recites a mobile telephone, and Krieter (See col. 4, line 53 – col. 5, line 13) teaches this feature.

Art Unit: 2625


Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent Numbers: 5,049,862 and **5,561,446**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL G. MARIAM whose telephone number is 571-272-7394. The examiner can normally be reached on M-F (7:00-4:30) FIRST FRIDAY OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BHAVESH M. MEHTA can be reached on 571-272-7453. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


DANIEL G MARIAM
Primary Examiner
Art Unit 2625

August 23, 2005